

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Xin Xue)
Serial No. 10/666,889)
Filed: September 17, 2003)
For: **METHOD OF AND SYSTEM**)
FOR AUTHENTICATION)
DOWNLOADING)
_____)

Group Art Unit: 2435

Examiner: To, BaoTRAN N.

**REPLY BRIEF IN RESPONSE TO
EXAMINER'S ANSWER**

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Sir:

In reply to the Examiner's Answer mailed on May 26, 2010, this Reply Brief is hereby submitted. Claims 1-44 have been rejected. The Appellant submits this brief to the Board of Patent Appeals and Interferences in compliance with the requirements of 37 C.F.R. § 41.41, as stated in *Rules of Practice Before the Board of Patent Appeals and Interferences (Final Rule)*, 69 Fed. Reg. 49959 (August 12, 2004).

The Appellant contends that the rejection of Claims 1-44 in this pending application is in error and should be overcome by this appeal. The appellant further contends that the Howard and Hori references do not support the rejection of Claims 1-44.

I. SUMMARY OF THE CLAIMED INVENTION

The invention disclosed in the present application number 10/666,889 is directed to methods, systems and devices for authorization and authentication downloading utilizing a removable memory having a set of authentication data. A user accesses a server with a handheld electronic device via a wireless Internet connection. The removable memory includes the set of authentication data. The handheld electronic device includes an interface to connect to the Internet when the removable memory is inserted into the handheld electronic device and a connection is formed with a server, using the set of authentication data, the server is able to authenticate the removable memory automatically without the user interfacing personally with the server. The server authenticates downloading to the removable memory in the handheld electronic device by reading the set of authentication data on the removable memory, and downloading the desired content to the removable memory.

II. ARGUMENTS RELATED TO REJECTION OF CLAIMS 1-44

A. Howard does not Teach the Presently Claimed Invention.

Howard is directed to a model relating to the payment for online content. Specifically, Howard teaches access is automatically granted to online content when the smart card is inserted into a reader attached to the user's PC, and cut off when the smart card is removed from the reader. [Howard, Abstract] However, as recognized within the Office Action dated February 18, 2009, Howard does not teach content being downloaded from a server to a removable memory. [Office Action of February 18, 2009, pages 7 and 8] Instead, Howard merely discloses transferring content from a content server to a user PC. [Howard, ¶ 0025] Accordingly, Howard does not teach the presently claimed invention.

B. Hori does not Teach the Presently Claimed Invention.

Hori is directed to a memory card that includes a memory to store encrypted content data. [Hori, Abstract] Specifically, Hori teaches a memory card receives the encrypted content data and license through cellular phone 100 and applies decryption on the above encryption, and then provides the decrypted data to the music reproduction unit in the cellular phone. [Hori, ¶ 0065]

Hori is only cited for the purpose of teaching content being downloaded from a server to a removable memory. Accordingly, Hori does not teach the presently claimed invention.

C. The Combination of Howard and Hori is improper because there is No Teaching, Suggestion or Motivation to Combine Howard and Hori.

Within the Examiner's Answer, it is reasserted that there is motivation to combine Howard with Hori because it would "prevent distributed copyrighted data from being replicated without permission of the copyright owner." [Examiner's Answer, page 13] However, as described in the Appeal Brief, this asserted motivation is false because the combination of Howard and Hori would not result in the prevention of distributed copyrighted data from being replicated without permission of the copyright owner. Indeed, the alleged motivation is nonexistent because there is no indication in Hori that downloading the content to the removable memory instead of the user PC would, on its own, prevent distributed copyrighted data from being replicated without permission of the copyright owner in Howard. On the contrary, Hori's prevention of impermissible replication relies on the entirety of the invention of Hori, including a complex data storage structure that comprises a plurality of authentication data hold means, a select means, a key hold means, a first decryption means, a session key generation means, a session key encryption means, and a session key decryption means.

As a result, even if Howard downloaded the content to the removable memory instead of the PC (as taught by Hori), Howard would be equally susceptible to copyright infringement. Thus, copyright protection cannot be the motivation for combining Howard and Hori. Howard would simply not be motivated to incorporate Hori for the above-asserted motivation because it simply does not provide any benefit (i.e. no increased copyright protection) while instead increasing complexity. Indeed, it is common sense that an inventor would not be motivated to combine two prior art references in order to achieve copyright protection benefits, if the asserted combination would not actually result in those benefits. Accordingly, the combination of Howard and Hori is improper because there is no motivation for their combination.

Also within the Examiner's Answer it is asserted that "Appellant's argument 'there is no indication in Hori that downloading the content to the removable memory instead of the user PC' that is not persuasive because the claimed limitation only requires 'downloading the content from the server to the removable memory' recited in claim 1." [Examiner's Answer, page 13] However, this argument at best is irrelevant and at worst is indecipherable. The entirety of the argument cited from the Appeal Brief states "[t]he alleged motivation is nonexistent because

there is no indication in Hori that downloading the content to the removable memory instead of the user PC would, on its own, prevent distributed copyrighted data from being replicated without permission of the copyright owner in Howard.” [Appeal Brief, page 8] This in no way is an assertion that the claims recite “downloading the content to the removable memory instead of the user PC,” but instead is just a description of what would need to occur to effectuate the proposed combination of Howard and Hori. Motivation for a combination is inherently tied to the consequences of said combination. Thus, even though the claims merely state “downloading the content from the server to the removable memory,” the fact that, on its own, downloading the content to the removable memory instead of the user PC in Howard would not result in further copyright protection indicates that assertion of such motivation is not valid. Therefore, again, the combination of Howard and Hori is improper because the combination of Howard and Hori would not result in the prevention of distributed copyrighted data from being replicated without permission of the copyright owner thereby lacking sufficient motivation.

Similarly, within the Examiner’s Answer it is asserted that “[i]n response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., downloading the content to the removable memory instead of the user PC) are not recited in the rejected claim(s).” [Examiner’s Answer, pages 13-14] However, as described above, the Appellant is not asserting that the claims recite “downloading the content to the removable memory instead of the user PC,” but instead arguing for a lack of motivation to combine the prior art references. Thus, the lack of the above cited language in claims is irrelevant to the argument. Accordingly, the combination of Howard and Hori lacks sufficient motivation.

Further within the Examiner’s Answer, it is asserted that “Howard’s reference and Hori’s reference are analogous arts ... [and] they both specifically disclose how to download the content from the content server that can support the motivation to combine the Howard’s teaching within Hori’s teaching to establish the limitations of Claims 1, 10, 19, 28, 36 and 44 that download the encrypted data from the content server (Hori, Abstract).” [Examiner’s Answer, page 14] However, as outlined in Section 2143.01 of the MPEP, a statement that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is *not sufficient* to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. MPEP § 2143.01, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993), emphasis added. Particularly, “rejections on obviousness cannot be sustained by mere

conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” MPEP § 2143.01, *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). In this case, the above assertions are merely statements that the references relied upon teach that all aspects of the claimed invention were individually known in the art. They contain no mention of any objective reason for the combination in either of the references. As described above, such an argument is not sufficient to justify the combination of Howard and Hori.

Finally, within the Examiner’s Answer it is asserted that there is “motivation to allow the user to access the content on [a] memory card with different terminals.” [Examiner’s Answer, page 15] However, this asserted motivation is not supported by a citation of either Howard or Hori. Instead, it is merely an unsupported conclusion. As described above, rejections on obviousness cannot be sustained by mere conclusory statements, rather support must be found within the references indicating the motivation to combine. Accordingly, the asserted motivation of allowing a user to access content on a memory card with different terminals is also not sufficient evidence of a motivation to combine Howard and Hori. Moreover, even if the above-alleged motivation was found in either Howard or Hori, similarly to the “copyright protection motivation,” there would still be no indication that the mere incorporation of the “downloading content to removable memory” of Hori into the system of Howard would actually result in Howard being able to allow user access to content on a memory card with different terminals. Indeed, again, such a benefit would need to be tied solely to the “downloading content to removable memory” of Hori in order for the benefit to actually transfer to Howard and provide any motivation for the combination. Therefore, even if the above-alleged motivation was found in either Howard or Hori, it would still be insufficient. Accordingly, the combination of Howard and Hori is improper due to lack of sufficient motivation.

D. The Combination of Howard and Hori would Change the Principle Mode of Operation of Howard.

The MPEP states “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 (CCPA 1959); MPEP §2143.01. Here, the invention of Howard operates under the principle that the content is downloaded to the user PC, not the removable memory. [Howard, ¶ 0025] As a result, modifying the invention of Howard to download the content to the removable

memory instead of the user PC as in Hori, is impermissible because it would change its principle mode of operation. Moreover, this impermissibility of the combination is even more apparent if all the elements necessary to actually achieve copyright protection in Hori were used to modify Howard. Specifically, such a modification of Howard would only further significantly, unnecessarily, and undesirably complicate Howard while simultaneously changing Howard's principle mode of operation. The extent to which Howard would need to be altered in order to incorporate the whole copyright protection means of Hori, as described above, would certainly result in a change to Howard's principal mode of operation because it would change the components and operation of both Howard's smart card and smart card reader. Accordingly, the combination of Howard and Hori is improper because it changes Howard's principle mode of operation.

Within the Examiner's Answer it is asserted that "the combination of Howard and Hori is proper because they both specifically disclose how to download the content from the server by using the smart card for granting access to online content as taught by Howard and downloading the content from the content server to the [removable memory] card for storing the content with copyright protection as taught by Hori." [Examiner's Answer, page 15] The Appellants respectfully disagree. The entirety of the argument asserted within the Examiner's Answer is merely a restatement of the elements of Howard and Hori followed by a conclusory statement that the combination would not change the principle mode of operation of Howard. No comment is made on what Howard's principle mode of operation is, nor is it explained how the combination with Hori would not change said operation. Conclusory statements are not sufficient justification to show that the combination would not change the principle mode of operation of Howard. Accordingly, again, the combination of Howard and Hori is improper because it would change Howard's principle mode of operation.

The independent Claim 1 is directed to a method of downloading content from a server to an electronic device. The method of Claim 1 comprises storing authentication data on a removable memory, wherein the authentication data includes a predetermined level of content access, accessing the server with the electronic device, authenticating the removable memory by reading the authentication data from the removable memory to determine the predetermined level of content access and downloading the content from the server to the removable memory according to the predetermined level of content access. As described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 1 is allowable over the teachings of Howard, Hori and their combination.

Claims 2-9 are dependent on the independent Claim 1. As described above, the independent Claim 1 is allowable over the teachings of Howard, Hori and their combination. Accordingly, Claims 2-9 are all also allowable as being dependent on an allowable base claim.

The independent Claim 10 is directed to a system for downloading content from a server to an electronic device. The system of Claim 10 comprises means for storing authentication data on a removable memory, wherein the authentication data includes a predetermined level of content access, further wherein the authentication data is preinstalled on the removable memory, means for receiving the removable memory in the electronic device, means for accessing the server with the electronic device, means for authenticating the removable memory by reading the authentication data from the removable memory to determine the predetermined level of content access and means for downloading the content from the server to the removable memory according to the predetermined level of content access. As described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 10 is allowable over the teachings of Howard, Hori and their combination.

Claims 11-18 are dependent on the independent Claim 10. As described above, the independent Claim 10 is allowable over the teachings of Howard, Hori and their combination. Accordingly, Claims 11-18 are all also allowable as being dependent on an allowable base claim.

The independent Claim 19 is directed to a system for downloading content. The system of Claim 19 comprises a removable memory, the removable memory including authentication data, the authentication data including a predetermined level of content access, an electronic device configured to receive the removable memory and a server, wherein when the electronic device accesses the server, the removable memory is authenticated by reading the authentication data from the removable memory and determining the predetermined level of content access, and further wherein once authenticated, content according to the predetermined level of content access is downloaded from the server to the removable memory. As described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 19 is allowable over the teachings of Howard, Hori and their combination.

Claims 20-27 are dependent on the independent Claim 19. As described above, the independent Claim 19 is allowable over the teachings of Howard, Hori and their combination. Accordingly, Claims 20-27 are all also allowable as being dependent on an allowable base claim.

The independent Claim 28 is directed to an electronic device for downloading. The device of Claim 28 comprises a memory slot configured to receive a removable memory, wherein the removable memory includes authentication data, the authentication data including a predetermined level of content access and a communications interface configured for coupling to

a server, wherein when the electronic device accesses the server through the communications interface, the removable memory is authenticated by reading the authentication data from the removable memory to determine the predetermined level of content access, further wherein content according to the predetermined level of content access is downloaded to the removable memory. As described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 28 is allowable over the teachings of Howard, Hori and their combination.

Claims 29-35 are dependent on the independent Claim 28. As described above, the independent Claim 28 is allowable over the teachings of Howard, Hori and their combination. Accordingly, Claims 29-35 are all also allowable as being dependent on an allowable base claim.

The independent Claim 36 is directed to a removable memory for downloading. The removable memory of Claim 36 comprises authentication data, the authentication data including a predetermined level of content access and a communications interface configured for coupling to a server, wherein when an electronic device accesses the server through the communications interface, the removable memory is authenticated by reading the authentication data from the removable memory to determine the predetermined level of content access, further wherein the electronic device includes a memory slot configured to receive the removable memory, and further wherein content according to the predetermined level of content access is downloaded to the removable memory, further wherein the predetermined level of content access determines how much of the content on the server is available for download. As described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 36 is allowable over the teachings of Howard, Hori and their combination.

Claims 37-43 are dependent on the independent Claim 36. As described above, the independent Claim 36 is allowable over the teachings of Howard, Hori and their combination. Accordingly, Claims 37-43 are all also allowable as being dependent on an allowable base claim.

The independent Claim 44 is directed to a method of downloading content from a server to an electronic device. The method of Claim 44 comprises storing authentication data on a removable memory, wherein the authentication data includes a predetermined level of content access, accessing the server with the electronic device, authenticating the removable memory by reading the authentication data from the removable memory to determine the predetermined level of content access and automatically downloading the content from the server to the removable memory according to the predetermined level of content access, wherein the authentication data is time stamped, such that the predetermined level of content access is available for a predetermined amount of time. As described above, the combination of Howard and Hori is

improper. For at least these reasons, the independent Claim 44 is allowable over the teachings of Howard, Hori and their combination.

III. CONCLUSION

In light of the above arguments, it is respectfully submitted that Claims 1-44 are allowable over the teachings of Howard and Hori because the combination of Howard and Hori is improper. Therefore, a favorable indication is respectfully requested.

Respectfully submitted,
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